REMARKS

Applicants and Applicants' attorney express appreciation to the Examiner for the courtesies extended during the recent interview held on June 16, 2004. The amendments and arguments presented by this paper are consistent with the proposed claims and arguments discussed during the Interview.

Claims 1-43 are pending, of which claims 1 and 15 are independent method claims, claim 31 is an independent computer program product corresponding to independent method claim 1, and claim 39 is an independent claim directed to a computer readable medium storing a data structure. As indicated above, claims 1, 15, 31, and 39-43, have been amended by this paper. Applicants note for the record that dependent claims 40-43 were amended only in order to use language that is consistent with the amendments to independent claim 39 and therefore do not evince an intent to surrender any subject matter.

The Office Action rejected claims 39-43 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. In response, Applicants have amended claims 39-43 to conform to the claim format approved by the Federal Circuit in that court's *In re Lowry* decision. *See, In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994). Accordingly, Applicants respectfully submit that the rejection of claims 39-43 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter has been overcome and should be withdrawn.

The Office Action rejected independent claims 1, 15, and 31 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5, 987,480 to Donohue et al. ("*Donohue*"); rejected independent claim 39 under 35 U.S.C. § 103(a) as being unpatentable over *Donohue* in view of U.S. Patent Publication No. US2003/0191817 A1 by Fidler ("*Fidler*"); and rejected the remaining dependent claims as either anticipated by *Donohue* under 35 U.S.C. § 102(e) or as unpatentable over *Donohue* in view of *Fidler* under 35 U.S.C. § 103(a).[1]

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131. That is, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed

[1] Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to do so in the future. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status or asserted teachings of the cited art.

invention either explicitly or impliedly." MPEP § 706.02. Applicants also note that "[i]n determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure.'" MPEP § 2121.01. In other words, a cited reference must be enabled with respect to each claim limitation.

Donohue discloses a document template with embedded markers for delivering documents having dynamic content. Col. 3, ll. 51-56; col. 4, ll. 36-37; Figure 2; Abstract. These markers may include dynamic content tags that are replaced with content retrieved from a data source. Col. 3, l. 56 – col. 4, l. 4. The markers also may include dynamic flow directives, such as IF or LOOP instructions. Col. 3, ll. 58-61; col. 4, ll. 47-58. Document templates may be selected to be compatible with a client computer's Internet browser type. Col. 5, ll. 5-11.

Donohue fails, however, to teach each and every element of Applicants' invention, as claimed in independent claims 1, 15, and 31. For example, among other things *Donohue* fails to teach or suggest identifying a template for displayable content based on the bandwidth available to send the displayable content to a first network device. The Interview Summary itself acknowledges that claims 1, 15, and 31, as amended, appear to overcome *Donohue*. Accordingly, Applicants respectfully submit that the rejection of independent claims 1, 15, and 31 under 35 U.S.C. § 102(e) as being anticipated by *Donohue* should be withdrawn.

With respect to independent claim 39, in order to establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143 (emphasis added). During examination, the pending claims are given their broadest reasonable interpretation, *i.e.*, they are interpreted as broadly as their terms reasonably allow, consistent with the specification. MPEP §§ 2111 & 2111.01.

In rejecting independent claim 39, the Office Action asserts that *Donohue* discloses token information table data that identifies locations in the template associated with data dictionary data, templates constant data, and functions data.[2] Office Action, p. 15 (rejection of claims 39 and 41). Applicants respectfully disagree.

The data structure stored on the computer-readable medium claimed in independent claim 39 includes compiled template data. This compiled template data comprises a token information

[2]The Office Action does not cite to *Fidler* with respect to this particular limitation.

table data object that identifies locations in the template associated with the data dictionary data object, the template constant data object, and the functions data object. While it is true that *Donohue* discloses a template parsing function to identify dynamic tags and flow directives, the Office Action fails to cite any teaching or suggestion in *Donohue* to store compiled template data that includes the locations within the template that are associated with a data dictionary data object, a template constant data object, and a functions data object. Col. 11, l. 26 – col. 12, l. 38; Figure 4. Accordingly, Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness with respect to independent claim 39 because the Office Action has failed to show that the prior art references, *Donohue* and *Fidler*, teach or suggest all the claim limitations recited in independent claims 39. Therefore, the rejection of claim 39 under 35 U.S.C. § 103(a) as being unpatentable over *Donohue* in view of *Fidler* is improper and should be withdrawn.

Based on at least the foregoing reasons, Applicants respectfully submit that the cited prior art fails to anticipate or make obvious Applicants invention, as claimed for example in independent claims 1, 15, 31, and 39. Applicants note for the record that the remarks above render the remaining rejections of record for the independent and dependent claims moot, and thus addressing individual rejections or assertion with respect to the teachings of the cited art is unnecessary at the present time, but may be undertaken in the future if necessary or desirable, and Applicants reserve the right to do so. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 27th day of July, 2004.

Respectfully submitted,

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